



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,904	09/16/2003	Kevin L. Corcoran	021919-001010US	8197

20350 7590 06/02/2004

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

YAN, REN LUO

ART UNIT PAPER NUMBER

2854

DATE MAILED: 06/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/667,904		CORCORAN ET AL.	
	Examiner		Art Unit	
	Ren L Yan		2854	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-9, 12 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirano(5,722,319) in view of Kokrhanek(4,542,691). The patent to Hirano teaches the method and system of an embossing apparatus as claimed including a sleeve or a force transfer assembly having a first part and a second part, or a first cover 341 and second cover 342, an embossing die pair 310 and 320 positioned between the first cover and the second cover so as to sandwich an embossing material X therebetween to enable an image pattern to be embossed on the embossing material X when the embossing system is placed on a die press. The first cover and the second cover are connected by a hinge 343 for being folded over and the pair of die plates 310 and 320 are held to their respective first and second covers 341 and 342 by Velcro adhesive material or indentation/projection connecting means 351 and 352. See Figs. 24-27 and column 9, line 66 through column 10, line 37 in Hirano for details. However, the pair of die plates 310 and 320 of Hirano may not be considered as a stencil and form pair as recited. The patent to Kokrhanek teaches an embossing system for embossing and decorating various articles the conventional use of a stencil 25 having perforations 26 thereon to define an embossing and decorating pattern, a foil 27 having a color layer and a mating form 28 to be pressed against the stencil 25 with an embossing material 23 being sandwiched in between so as to create an embossed and decorative color design on the material 23 in one operation. See Figs. 5 and 6,

Art Unit: 2854

and column 3, line 61 through column 4, line 18 in Kokrhanek for example. It would have been obvious to one of ordinary skill in the art to provide the embossing system of Hirano with the stencil and form pair along with a foil having a color layer appropriately disposed as taught by Kokrhanek in order to create an embossed and decorative color design on the embossing material. With respect to claims 6 and 7, Kokrhanek teaches in column 3, lines 14-19 to make the stencil with metal and in column 4, lines 25-34 to make the form with a plastic material. With respect to claim 12, see Fig. 26 in Hirano for the recited clearance.

Claims 4, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirano in view of Kokrhanek as applied to claims 3 and 9 above, and further in view of McLaughlin et al(4,979,613). Hirano, as modified by Kokrhanek teaches all that is claimed except for the use static vinyl to attach the form to the cover member. McLaughlin et al teach the conventionality of using high static vinyl material as the fastening element to releasably attach article surfaces together so that the article surfaces are capable of being repeatedly fastened, separated, and refastened. See column 3, lines 12-45 in McLaughlin et al for example. In view of the teaching of McLaughlin et al, it would have been obvious to those having ordinary skill in the art to provide the embossing system of Hirano, as modified by Kokrhanek with the high static vinyl material as the fastening means to releasably attach the stencil and the form to their respective covers so as to achieve a simple and effective way to repeatedly attach and detach the stencil and form to suit various embossing and decorating tasks.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hirano in view of Kokrhanek as applied to claim 9 above, and further in view of Fuqua et al(5,188,026).

Art Unit: 2854

Hirano, as modified by Kokrhanek teaches all that is claimed except for the use of apertures on the force transfer assembly to be engaged with pins on a die press. Fuqua et al teach a pin register system for screen printers the conventional use of apertures 106 and 108 on a screen frame 50 to be engaged with register pins 56 and 194 on the printer when the screen frame 50 is placed onto the printer in order to accurately align the screen frames relative to one another and to the printer. See Figs. 7-20 and claim 3 in Fuqua et al for example. In view of the teaching of Fuqua et al, it would have been obvious to those having ordinary skill in the art to provide the force transfer assembly of Hirano, as modified by Kokrhanek with apertures to be engaged with pins on a die press in order to accurately align the force transfer assembly relative to the die press each time the force transfer assembly is mounted onto the die press.

Claims 14-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirano in view of Kokrhanek as applied to claim 9 above, and further in view of Meth(5,590,910). Hirano, as modified by Kokrhanek teaches all that is claimed except for the various hinge material as recited and the hinge is not a reduced thickness area joining the first and second covers. Meth teaches different types of hinges to be used in a clipboard device that allow two members 40 and 51 to pivot relative to each other. Meth in column 3, lines 49-60 teaches various conventional hinge materials such as clear-plastic hinges, strong tape material, etc. Meth also teaches in Fig. 7 hinge 46 to be a reduced thickness area joining the two members 40 and 51. In view of the teaching of Meth, it would have been obvious to those having ordinary skill in the art to provide the first and second covers of Hirano, as modified by Kokrhanek with the various known hinge materials as taught by Meth as obvious mechanical alternatives to achieve the same pivotal function of the covers and to provide the hinge with a reduced thickness area so as to facilitate

Art Unit: 2854

the pivotal movement of the covers. With respect to claims 20 and 21, the recited clearance is clearly shown in Fig. 26 of Hirano.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ren L Yan whose telephone number is 571-272-2173. The examiner can normally be reached on 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on 571-272-2168. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ren L Yan
Primary Examiner
Art Unit 2854

Ren Yan
May 26, 2004